

**REMARKS**

**Summary of the Office Action**

Claims 1, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,167,235 to Seacord et al. (hereinafter Seacord).

Claims 1 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,018,872 to Suszynski et al. (hereinafter Suszynski).

Claims 2, 9, 15-16 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord in view of U.S. Patent No. 3,581,570 to Wortz.

Claims 2-6, 9-10, 15-16 and 19, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski in view of Wortz.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski and Wortz as applied to claims 2-6, 9-10, 15-16 above, and further in view of U.S. Patent No. 5,906,437 to Lin.

Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski in view of U.S. Patent No. 4,775,586 to Bohrn et al. (hereinafter Bohrn).

Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord in view of Bohrn.

The Examiner is thanked for indicating that claims 7-8 include allowable subject matter.

**Summary of the Response to the Office Action**

Applicants have amended independent claims 1 and 17 to differently define the invention and amended claims 2, 4-7 and 12 to improve their form. Also, Applicants have canceled claim 3 without prejudice or disclaimer. Accordingly, claims 1, 2, 4-10 and 12-19 remain pending for further consideration.

**All Claims Comply with 35 U.S.C. § 103**

Claims 1, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,167,235 to Seacord et al. (hereinafter Seacord). Claims 1 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,018,872 to Suszynski et al. (hereinafter Suszynski). Claims 2, 9, 15-16 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord in view of U.S. Patent No. 3,581,570 to Wortz. Claims 2-6, 9-10, 15-16 and 19, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski in view of Wortz. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski and Wortz as applied to claims 2-6, 9-10, 15-16 above, and further in view of U.S. Patent No. 5,906,437 to Lin. Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suszynski in view of U.S. Patent No. 4,775,586 to Bohrn et al. (hereinafter Bohrn). Claims 13 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Seacord in view of to Bohrn. To the extent that these rejections might be reapplied to the claims as newly amended, they are respectfully traversed as

being based on a combination of references that neither teaches nor suggests the novel combination of features now recited in the claims.

With respect to independent claim 1, as newly-amended, Applicants respectfully submit that Seacord does not teach or suggest a claimed combination including at least a feature of “the base body (12) is provided with at least one air chamber (13; 18, 20) at least in parts to improve heat insulation between the temperature measurement probe (30) and the body cavity (31).” The Office Action primarily relies upon Seacord and Suszynski to allege that each of the two applied references discloses the invention of independent claim 1. Applicants respectfully disagree with this assertion in the Office Action.

Specifically, regarding Seacord, Applicants respectfully submit that Seacord does not disclose a protective cap as recited in newly-amended independent claim 1. In fact, Seacord discloses a disposable sheath 16 as shown in FIG. 2 and as described in last two lines of col. 3. The sheath 16 of Seacord includes a tip portion 40, an end 42, and a conical wall 44, as described at col. 5, lines 40-43 of Seacord. As shown in FIG. 2 and described at col. 5, lines 45-48 of Seacord, the tip portion 40 and the conical wall 44 are bulk portion while a window at the end 42 is very thin. Further, while the Office Action appears to indicate that the disposable sheath 16 contains an insulation 34, Applicants respectfully submit that the sheath 16 of Seacord merely consists of plastic material, as described at col. 5, lines 49-61 of Seacord and the insulation 34, as mentioned in col. 4, line 67 of Seacord has nothing to do with the sheath 16.

Accordingly, Applicants respectfully submit that Seacord fails to teach or suggest the claimed combination including the feature that “the base body (12) is provided with at least one

air chamber (13; 18, 20) at least in parts to improve heat insulation between the temperature measurement probe (30) and the body cavity (31),” as recited by newly-amended independent claim 1.

Regarding Suszynski, Applicants respectfully submit that Suszynski does not disclose a protective cap as recited in newly-amended independent claim 1. In fact, Suszynski discloses a thermometer including a probe 13 that is defined by a plastic tube 17 at col. 3, lines 9-10. Suszynski also discloses a disposable protective probe cover 41 having a plastic film 43 that can be stretched over a plastic tube 17 of the probe 13 at col. 4, lines 46-62. Moreover, Suszynski discloses that the outer surface of the plastic tube 17 can have a roughened texture so that small air pockets 51 are formed between the plastic film 43 of the probe cover 41 and the plastic tube 17 of the probe 13 at col. 5, lines 5-13. Therefore, Applicants respectfully submit that Suszynski does not disclose a probe cover having an air chamber as recited in newly-amended independent claim 1. In other words, Applicants respectfully submit that Suszynski fails to teach or suggest the claimed combination including the feature that “the base body (12) is provided with at least one air chamber (13; 18, 20) at least in parts to improve heat insulation between the temperature measurement probe (30) and the body cavity (31),” as recited by newly-amended independent claim 1.

For similar reasons as those set forth above, Applicants respectfully submit that Seacord and Suszynski, whether taken singly or combined, do not teach or suggest “the protective cap (2) includes a base body (12) provided with at least one air chamber (13; 18, 20) to improve heat

insulation between the temperature measurement probe (30) and the body cavity (31)," as recited in newly-amended independent claim 17.

Applicants further assert that the Office Action does not rely on Wortz, Lin and Bohrn to remedy the deficiencies of Seacord and Suszynski. Further, Applicants respectfully submit that Wortz, Lin and Bohrn cannot remedy the deficiencies of Seacord and Suszynski.

As pointed by MPEP § 2143.03 instructs that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Thus, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and that the rejections under 35 U.S.C. § 103(a) are improper.

Accordingly, for at least the reasons set forth above, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because Seacord, Suszynski, Wortz, Lin and Bohrn, whether taken singly or combined, fail to teach or suggest each feature of independent claims 1 and 17, as newly-amended. Furthermore, Applicants respectfully assert that the rejections of dependent claims 2, 4-10, 12-16 and 18-19 should also be withdrawn at least because of their respective dependencies upon newly-amended independent claims 1 and 17 and for the reasons set forth above.

Since Applicants have canceled claim 3 without prejudice or disclaimer, the rejection of claim 3 becomes moot.

With no other rejection pending, Applicants respectfully submit that claims 1, 2, 4-11 and 12-19 are in condition for allowance.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

By: Donald L. Monin, Jr.  
Donald L. Monin, Jr.  
Reg. No. 47,256

Date: December 21, 2004

Customer No.: 009629  
**MORGAN, LEWIS & BOCKIUS LLP**  
1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
Telephone: 202-739-7000  
Facsimile: 202-739-3001